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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,545	03/25/2004	Kunihiro Ichimura	1417-457	4886
23117	7590	11/29/2005	EXAMINER	
NIXON & VANDERHYE, PC			KUGEL, TIMOTHY J	
901 NORTH GLEBE ROAD, 11TH FLOOR			ART UNIT	PAPER NUMBER
ARLINGTON, VA 22203			1712	

DATE MAILED: 11/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/808,545	ICHIMURA ET AL.
	Examiner Timothy J. Kugel	Art Unit 1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 29 July 2005 and 01 November 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 4-17 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-3 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/7/05</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

1. Claims 1-17 are pending as filed on 25 March 2005. Claims 4-17 have been withdrawn from further consideration.

***Election/Restrictions***

2. Claim 17 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 29 July 2005.

3. Claims 4-16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 1 November 2005.

***Priority***

4. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Information Disclosure Statement***

5. Regarding the reference EP1264866, the information disclosure statement filed 7 January 2005 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. However, as US Patent 6623557 is the US equivalent to EP1264866 the Information Disclosure statement has been initialed and signed and has been placed in the application file.

***Specification***

6. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-3 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 6 of U.S. Patent No. 6,596,071 (Hayashi '071 hereinafter).

Although the conflicting claims are not identical, they are not patentably distinct from each other because Hayashi '071 claims a transparent color paint composition

comprising a solvent, composite particles having an average diameter of 0.01 to 10.0  $\mu\text{m}$ —which converts to 10 to 10,000 nm by standard conversion—comprising white inorganic particles, a gluing agent formed on the surface of said white inorganic particles wherein the amount of gluing agent is 1 to 200% based on the weight of the white inorganic particles, an organic pigment coat formed on the gluing agent layer; therefore claim 6 of Hayashi '071 fully embraces the claims of the instant application.

9. Claims 1-3 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 9 of U.S. Patent No. 6,737,211 (Hayashi '221 hereinafter).

Although the conflicting claims are not identical, they are not patentably distinct from each other because Hayashi '211 claims a transparent color toner composition comprising a solvent—a binder resin—composite particles having an average diameter of 0.005 to 0.30  $\mu\text{m}$ —which converts to 5 to 300 nm by standard conversion—comprising white inorganic particles, a gluing agent formed on the surface of said white inorganic particles wherein the amount of gluing agent is 1 to 500% based on the weight of the white inorganic particles, an organic pigment coat formed on the gluing agent layer; therefore claim 9 of Hayashi '211 fully embraces the claims of the instant application.

10. Claims 1-3 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 7, 18 and 19 of U.S. Patent No. 6,623,557 (Hayashi '557 hereinafter).

Although the conflicting claims are not identical, they are not patentably distinct from each other because Hayashi '557 claims a composition comprising a solvent—water—composite particles having an average diameter of 0.001 to 0.15  $\mu\text{m}$ —which converts to 1 to 150 nm by standard conversion—comprising inorganic particles, a gluing agent formed on the surface of said white inorganic particles wherein the amount of gluing agent is 1 to 500% based on the weight of the inorganic particles, an organic pigment coat formed on the gluing agent layer.

Since Hayashi '557 claims the same composition as instantly claimed, one of ordinary skill in the art at the time the invention was made would have expected that the transparency of the Hayashi '557 composition would inherently be the same as claimed; therefore the claims of Hayashi '557 fully embrace the claims of the instant application.

11. Claims 1-3 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/253,906.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application claims a coloring composition comprising particles with an average diameter of 0.001 to 1.0  $\mu\text{m}$ —which converts to 1 to 1,000 nm by standard conversion—comprising white inorganic particles, a gluing agent formed on the surface of said white inorganic particles wherein the amount of gluing agent is 1 to 500% based on the weight of the white inorganic particles, an organic pigment coat formed on the gluing agent layer, and a solvent.

Since the copending application claims the same composition as instantly claimed, one of ordinary skill in the art at the time the invention was made would have expected that the transparency of the copending application's composition would inherently be the same as claimed; therefore claim 1 of the copending application fully embraces the claims of the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102 and/or 35 USC § 103***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by European Patent EP1270686. US Patent 6,596,071 (Hayashi '071 hereinafter) is the US equivalent to EP1270686 and all references herein are taken therefrom.

Hayashi '071 teaches a transparent color paint (Column 4 Lines 33-45) composition comprising a solvent (Column 12 Lines 41-45), composite particles having an average diameter of 0.01 to 10.0  $\mu\text{m}$ —which converts to 10 to 10,000 nm by standard conversion—comprising white inorganic particles, a gluing agent formed on

the surface of said white inorganic particles wherein the amount of gluing agent is 1 to 200% based on the weight of the white inorganic particles, an organic pigment coat formed on the gluing agent layer (Abstract, Column 3 Line 5 – Column 4 Line 25 and Claim 6).

14. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by European Patent EP1253477. US Patent 6,737,211 (Hayashi '211 hereinafter) is the US equivalent to EP1253477 and all references herein are taken therefrom.

Hayashi '221 teaches a transparent color toner composition comprising a solvent—a binder resin—composite particles having an average diameter of 0.005 to 0.30  $\mu\text{m}$ —which converts to 5 to 300 nm by standard conversion—comprising white inorganic particles, a gluing agent formed on the surface of said white inorganic particles wherein the amount of gluing agent is 1 to 500% based on the weight of the white inorganic particles, an organic pigment coat formed on the gluing agent layer (Abstract, Column 2 Line 65 – Column 3 Line 32, Column 3 Lines 53-58 and Claims 1 and 9).

15. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent Application 2002/0069790 (Hayashi '790 hereinafter).

Hayashi '790 teaches a transparent coloring composition (¶0098) comprising a solvent based paint (¶0168) comprising composite particles having an average diameter of 0.001 to 1.0  $\mu\text{m}$ —which converts to 1 to 1,000 nm by standard conversion—comprising white inorganic particles, a gluing agent formed on the surface of said white inorganic particles wherein the amount of gluing agent is 1 to 500% based on the weight

of the white inorganic particles, an organic pigment coat formed on the gluing agent layer (Abstract, ¶¶0015-0094, Claims 1, 12, 20, 26, 37, 44 and 58).

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over European Patent EP1264866. US Patent 6,623,557 (Hayashi '557 hereinafter) is the US equivalent to EP1264866 and all references herein are taken therefrom.

Hayashi '557 teaches a composition comprising a solvent based ink jet printer ink (Column 14 Lines 37-42) comprising composite particles having an average diameter of 0.001 to 0.15 µm—which converts to 1 to 150 nm by standard conversion—comprising white inorganic particles, a gluing agent formed on the surface of said white inorganic particles wherein the amount of gluing agent is 1 to 500% based on the weight of the white inorganic particles, an organic pigment coat formed on the gluing agent layer, and a solvent (Abstract, Column 3 Line 35 – Column 5 Line 40 and Claims 1, 7, 18 and 19).

Since Hayashi '557 the same composition as instantly claimed, one of ordinary skill in the art at the time the invention was made would have expected that the transparency of the Hayashi '557 composition would inherently be the same as claimed.

Where applicant claims a composition in terms of a function, property or characteristic and the composition of the prior art is the same as that of the claim but the function is not explicitly disclosed by the reference, the examiner may make a rejection under both 35 U.S.C. 102 and 103. "There is nothing inconsistent in concurrent rejections for obviousness under 35 U.S.C. 103 and for anticipation under 35 U.S.C. 102." *In re Best*, 562 F.2d 1252, 1255 n.4, 195 USPQ 430, 433 n.4 (CCPA 1977).

18. Claims 1-3 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US Patent Application Publication US 2003/0116758 (Morii hereinafter).

Morii teaches a coloring composition comprising particles with an average diameter of 0.001 to 1.0  $\mu\text{m}$ —which converts to 1 to 1,000 nm by standard conversion—comprising white inorganic particles, a gluing agent formed on the surface of said white inorganic particles wherein the amount of gluing agent is 1 to 500% based on the weight of the white inorganic particles, an organic pigment coat formed on the gluing agent layer, and a solvent (Abstract, ¶¶0025-0043, Claim 1).

Since the copending application claims the same composition as instantly claimed, one of ordinary skill in the art at the time the invention was made would have expected that the transparency of the copending application's composition would inherently be the same as claimed.

Where applicant claims a composition in terms of a function, property or characteristic and the composition of the prior art is the same as that of the claim but the function is not explicitly disclosed by the reference, the examiner may make a

rejection under both 35 U.S.C. 102 and 103. "There is nothing inconsistent in concurrent rejections for obviousness under 35 U.S.C. 103 and for anticipation under 35 U.S.C. 102." *In re Best*, 562 F.2d 1252, 1255 n.4, 195 USPQ 430, 433 n.4 (CCPA 1977).

The applied reference has a common assignee and common inventors with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

### ***Conclusion***

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy J. Kugel whose telephone number is (571) 272-1460. The examiner can normally be reached Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TJK  
Art Unit 1712



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